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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,629

12/13/2004

Gunther Schoffner

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02/08/2006

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EXAMINER

NGUYEN, CHAU N

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/517,629	SCHOFFNER, GUNTHER	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chau N. Nguyen	2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/14/05</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment to the claims filed on 12/13/04 does not comply with the requirements of 37 CFR 1.121(c) which states that the text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. Added text to claim 1, specifically lines 5 and 8-9 is not underlined.

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of a connecting element comprising all the features as recited in claim 1 along with a mounting apparatus for the electrical conductor arranged on the connecting element as claimed in claim 7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Specifically, claim 1 recites limitations supported by Figure 5 of the drawings. Claim 7 depends on claim 1

and further recites a mounting apparatus for the electrical conductor arranged on the connecting element, which is not shown in Figure 5.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Also, as noted in the present application, there is a drawing set with 4 drawing sheets, 4 Figures which do not show any relationship with the claimed

subject matter of "connecting element for a mechanical and electrically conductive connection". However, the 4 drawing sheets have labeled thereon docket number, inventor name, and title matching with the application. Please verify this issue.

For the examination purpose, examiner bases on the drawings disclosed in the PCT/DE03/01388.

### ***Specification***

2. The disclosure is objected to because of the following informalities: on page 9, line 19, change "26" to --23--. Appropriate correction is required.

### ***Claim Objections***

3. Claims 2-4, 6, 9 and 10 are objected to because of the following informalities:

in claim 2, line 4, "its insertion" is unclear to which element is preferred to,

in claim 3, line 4, "its insertion" is unclear to which element is preferred to,

in claim 4, line 6, "a wedge" is unclear to how this wedge relates to

"wedges" recited earlier in claim 1,

in claim 6, line 4, change "the connecting element" to --the at least one spreading element--,

in claim 9, line 10, delete "an electrical conductor", and

in claim 10, line 10, delete "an electrical conductor". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2, 3 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for the claimed subject matter recited in claims 1 and 2; claims 1 and 3; and claims 1 and 7, respectively. In other words, as shown in the drawings and disclosed in the specification, Figures 1-6 are directed to 6 patentably distinct species respectively (6 different embodiments). Claim 1, as amended, recites limitations solely supported by Figure 5. On the other hand, claim 2 recites limitations supported by Figure 2 (page 9, lines 28-33), claim 3 recites limitations supported by Figure 1 (page 8, lines 11-18), and claim 7 recites

limitations supported by either Figure 1 or Figure 4. There is no disclosure supporting the combination between Figures 5 and 2; Figures 5 and 1; or Figures 5 and 4 respectively.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-10, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hockele (DE 2250441).

Hockele discloses, Figure 2, a connecting element for a mechanical and electrically conductive connection comprising an electrical conductor (1, 2) which has a cutout in its outer contour in which at least one spreading element (106, 107), of the connecting element can be inserted and can be actuated by means of an operating element arranged within the outer contour of the connecting element in order to brace it in the cutout, wherein the operating element has a hinged plate (120) and a movable plate (120) between which wedges (122) can be inserted which drive the plates away from one another (re claims 1, 9 and 10). Hockele

also discloses that the spreading element can be braced by means of a bracing movement which is directed parallel to a direction of the insertion of the spreading element (re claim 2) or which is directed perpendicular to a direction of the insertion of the wedges (re claim 3), the bracing of the spreading element can be brought about by faces which can be moved relative to one another and are arranged in relation to one another in form of a wedge (119) in cross section (re claim 4), the faces are conical (re claim 5), the at least one spreading element has at least one first and at least one second spreading element which each have an associated first and second electrical conductor (re claim 6), a mounting apparatus (117) for the electrical conductor arranged on the connecting element (re claim 7), and the electrical conductor is an inner conductor of a compressed gas-insulated tubular conductor (re claim 8).

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N. Nguyen whose telephone number is 571-272-1980. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31.



The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Art Unit 2831